



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------------------------------------------------------------|-------------|----------------------|--------------------------|------------------------|
| 10/595,846 | 05/16/2006 | Heino Weigand | GK-ZEI-3305/500343.20326 | 7835 |
| 26418 | 7590 | 06/17/2008 | | |
| REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650 | | | EXAMINER JONES, JAMES | |
| | | | ART UNIT 2873 | PAPER NUMBER |
| | | | MAIL DATE 06/17/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,846

Applicant(s)

WEIGAND ET AL.

Examiner

JAMES C. JONES

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Harino et al (6238385) hereafter '385.

'385 discloses the limitations therein including the following:

Regarding claim 11 '385 discloses a method of orienting the eye of a patient to help prevent the eye from moving in a manner that would interfere with treatment being carried out by an for ophthalmologic treatment devices (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58), the method comprising the steps of: projecting the a fixation mark to be displayed in the field of vision of the eye to be treated (fig. 8); allowing the patient to orient the eye to be treated on this fixation mark through foveal fixation (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58); and moving the fixation mark in the field of vision of the patient, wherein the movement of the fixation mark is used to position the eye in a specific manner so that (a) the patient can easily follow the fixation mark and (b) the eye is less likely to move in a manner that would interfere with the treatment being carried out by the ophthalmologic treatment device (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sponsel et al. (2004/0046934) hereafter '934 in view of Harino et al (6238385) hereafter '385.

Regarding claim 11-14 and 16 '934 discloses a method for displaying a fixation mark for ophthalmologic treatment devices (par. [0033]) comprising the steps of: projecting the fixation mark to be displayed in the field of vision of the eye to be treated (fig. 3-7, par. [0047]); moving the fixation mark in the field of vision of the patient, wherein the movement is carried out in such a way that the patient can easily follow the fixation mark; movement of the fixation mark in the field of vision of the patient is carried out continuously or discontinuously, according to a predetermined sequence, or randomly; the fixation mark is moved discontinuously in the field of vision of the patient, diagnosis or therapy being carried out only within short stationary phases of the fixation mark; the fixation mark is moved in the field of vision of the patient and a measurement or therapy is carried out while the eye follows the movement of the fixation mark; the movement of the fixation mark is used to position the eye in a specific manner; and the movement of the fixation mark is carried out through variable projection on a stationary

display (fig. 3-7, par. [0047]-[0048]) but does not specifically disclose the ophthalmic device allowing the patient to orient the eye to be treated on the fixation mark through foveal fixation. '385 teaches that in an ophthalmic device it is desirable to allow the patient to orient the eye to be treated on the fixation mark through the foveal fixation (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58) for the purpose of reducing undesired movements of the eye. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the method of allowing the patient to orient the eye to be treated on the fixation mark through the foveal fixation in the ophthalmic device of '934 as modified by '385 since '385 teaches that in an ophthalmic device it is desirable to allow the patient to orient the eye to be treated on the fixation mark through the foveal fixation for the purpose of reducing undesired movements of the eye.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sponset et al. (2004/0046934) hereafter '934 in view of Harino et al (6238385) hereafter '385. further in view of Jernigan (3984156) hereafter '156.

Regarding claims 17-20 Sponset ('934) and Harino ('385) disclose as set forth above but does not specifically disclose the movement of the fixation mark is carried out by an XY mirror unit; a movement of the fixation mark in the field of vision of the patient of a diagnostic beam or therapeutic beam is carried out by a XY mirror unit; a movement of a diagnostic beam or therapeutic beam is corrected by a predetermined movement of the fixation mark; and a movement of a diagnostic beam or therapeutic beam is corrected by the movement of the fixation mark which is acquired online. '156

further teaches that in an ophthalmic device it is further desirable to have the movement of the fixation mark carried out by an XY mirror unit; the movement of the fixation mark an of a diagnostic beam or therapeutic beam carried out by the same XY mirror unit; the movement of a diagnostic beam or therapeutic beam corrected by the predetermined movement of the fixation mark; and the movement of a diagnostic beam or therapeutic beam corrected by the movement of the fixation mark which is acquired online (fig. 1, col. 15, ln. 42-68 and col. 16, ln. 1-17) for the purpose of monitoring the movements of the eyes and responses of the target positions during measuring and evaluating a patient's visual field (abstract, ln. 1-8 of '156). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the method of the movement of the fixation mark carried out by an XY mirror unit; the movement of the fixation mark an of a diagnostic beam or therapeutic beam is carried out by the same XY mirror unit; the movement of a diagnostic beam or therapeutic beam is corrected by the predetermined movement of the fixation mark; and the movement of a diagnostic beam or therapeutic beam is corrected by the movement of the fixation mark which is acquired online in the ophthalmic device of '934 as modified by '385 and further modified by '156 since '156 further teaches that in an ophthalmic device it is further desirable to have the movement of the fixation mark carried out by an XY mirror unit; the movement of the fixation mark an of a diagnostic beam or therapeutic beam carried out by the same XY mirror unit; the movement of a diagnostic beam or therapeutic beam corrected by the predetermined movement of the fixation mark; and the movement of a diagnostic beam or therapeutic beam corrected by the

movement of the fixation mark which is acquired online for the purpose of monitoring the movements of the eyes and responses of the target positions during measuring and evaluating a patient's visual field.

Response to Arguments

Applicant's arguments with respect to claims 11-14 and 16-20 have been considered but are moot in view of the new ground(s) of rejection.

I. With respect to claim 21 the 35 USC 112 rejection has been withdrawn due to the fact that applicant has cancelled claim 21.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES C. JONES whose telephone number is (571)270-1278. The examiner can normally be reached on Monday thru Friday, 8 a.m. to 5 p.m. est. time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2873

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James C. Jones/
Examiner, Art Unit 2873
6/12/2008

/Jordan M. Schwartz/
Primary Examiner, Art Unit 2873